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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/722,529	11/28/2003	An-Ming Wu	33677.5	7601

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CANADA

EXAMINER

FIGUEROA, JOHN J

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 07/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/722,529	Applicant(s) WU ET AL.	
	Examiner John J. Figueroa	Art Unit 1712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 27-33 and 41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 27-33 and 41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The objections regarding the specification in items 4-5 on page 4 of the Office Action of January 20, 2006 (hereinafter 'OA') have been withdrawn in view of Applicant's amendment to the specification.
2. The 35 U.S.C. 102(b) rejection of claims 27-33 in item 7 on page 5 of OA as anticipated by United States Patent Number (USPN) 2,288,857 to Subkow has been withdrawn in view of Applicant's amendment to the claims filed April 20, 2006 (hereinafter 'Amendment').

Election/Restrictions

3. Applicant's election to prosecute the claims of Group III, process for making an emulsified drilling fluid, were made with traverse as indicated in OA. The restriction has been acknowledged by Applicant in item 2(a) on page 7 of Amendment. Applicant has further canceled claims 1, 3-26 and 34-40 and has not provided an argument for the traversal.

Thus, the restriction requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 27-33 and 41 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Amended independent claim 27 now recites the limitation "surfactants having HLB numbers equal or greater than approximately 7 *but not exceeding approximately 13*" [emphasis added]. Although there is support throughout the specification for surfactants having an HLB number equal to or greater than 7, there is no written description support for HLB numbers "not exceeding approximately 13." Accordingly, there is a lack of proper written description support in the specification for this limitation in independent claim 27 and, therefore, the claims are rejected due to containing new matter.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 27-33 and 41 are rejected under 35 U.S.C. 102(b) as being anticipated by USPN 5,634,984 to Van Slyke (hereinafter Van Slyke).

Van Slyke discloses a cleaning fluid that can be part of a “primary” oil-based drilling fluid to be used in a process for drilling a borehole in a subterranean formation, said cleaning fluid comprising a base oil, one or more surfactants, a viscosifier, a weighting agent and a fluid loss control agent, wherein said surfactant is substantially uniformly distributed throughout the base oil and has an HLB value of at least about 8. (Col. 3, line 25 to col. 4, line 16; col. 4, lines 35-51; Table I)

Van Slyke discloses that the surfactant can be, e.g., an ethoxylated alkyl phenol, a glycerol ester, a sulfate of ethoxylated alcohol, an alkyl ethoxylated sulfonate or an alkylaryl sulfonate, and that the typical HLB value of the surfactant is about 9. (Col. 2, lines 26-43; Col. 10, lines 43-48; See, e.g., Table VII on col. 9 for list of surfactants having HLB values of, e.g., 8.6 and 11). Van Slyke further discloses the cleaning fluid/composition further containing water (an aqueous fluid) in amounts of from less than 1 percent to about 20 percent water. (Col. 10, lines 49-63).

An exemplary oil-based drilling fluid disclosed by Van Slyke contains 50-60% oil, 10-20% water (aqueous fluid), an active surfactant, a weighting agent, organophilic clay, a polymeric fluid loss control agent, a non-polymeric fluid loss agent, a polymeric viscosifier (such as, calcium carbonate and clay), shale inhibiting salt (such as, sodium chloride and calcium chloride) and lime. (Col. 17, line 65 to col. 18, line 47; Table VII

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and Table X) In addition, Table A discloses that among the surfactants that can be used in the drilling fluid/composition is, e.g. aluminum stearate, a well-known defoamer.

Moreover, the drilling fluid/composition containing a hydrophilic surfactant disclosed by Van Slyke, when used in a drilling process, enables for the easy transport of the oil-contaminated cuttings within the emulsified drilling fluid from the well bore to a washer/shaker. (Col. 18, line 48 to col. 19, line 19; Figure 1)

Thus, the claims are anticipated by Van Slyke.

Response to Arguments

The Objections to the Specification

8. Applicant's remarks in item 1 of Amendment concerning the objections to the disclosure (items 4 and 5 on page 4 of OA) being withdrawn upon entry of Amendment have been fully considered and are persuasive. These objections have been withdrawn.

The 35 U.S.C. 102 Rejection over Subkow (item 7 on page 5 of OA)

9. Applicant's arguments regarding the 35 U.S.C. 102 (b) rejection of claims 27-33 as anticipated by Subkow have been considered but have become moot due to the new grounds of rejection in view of Amendment.

10. However, if Applicant withdraws or cancels the amendment to claim 27 to overcome the 35 U.S.C. 112, 1st paragraph new matter rejection discussed above in paragraph #5, then this rejection over Subkow will be reinstituted.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John J. Figueroa whose telephone number is (571) 272-8916. The examiner can normally be reached on Mon-Thurs & alt. Fri 8:00-5:30pm.

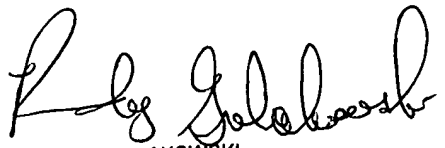
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JJF/RAG


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